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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,022	07/06/2001	Yukitoshi Takeuchi	35.C15547	3535
5514	7590	11/17/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			THOMPSON, JAMES A	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/899,022

Applicant(s)

TAKEUCHI ET AL.

Examiner

James A. Thompson

Art Unit

2625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 November 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-4, 7 and 13.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


KING Y. POON

PRIMARY EXAMINER

DETAILED ACTION

Response to Amendment

1. Applicant's proposed amendments are merely amendments to improve the form of the claims, particularly claim 13. Thus, the **proposed amendments are entered.**

Response to Arguments

2. Applicant's arguments filed 06 November 2006 have been fully considered but they are not persuasive.

Applicant argues that (1) Examiner has used impermissible hindsight; (2) neither Lee (US Patent 6,233,426) nor Fujitaka (US Patent 5,541,712) teach cover member biasing in a direction parallel to a hinge-member, rotary-shaft axis; (3) neither Lee nor Fujitaka teach cover-member, spring biasing in a direction parallel to a hinge-member, rotary-shaft axis; and (4) there is no motivation to combine Lee and Fujitaka.

Examiner replies, with respect to argument (1), that Applicant's allegation of impermissible hindsight is not based on what is generally considered "impermissible hindsight". While Applicant clearly contests whether or not the citations provided by Examiner truly teach what Examiner has claimed said citations teach, this is in no way relevant to the doctrine of "impermissible hindsight". Examiner has in no way relied upon Applicant's disclosure in either teaching the limitations of the claims obvious or in combining Lee and Fujitaka in a rejection based on obviousness.

With respect to arguments (2) and (3), Examiner would first like to point out that the precise wording of the relevant limitation in the claim "wherein said cover member is biased in

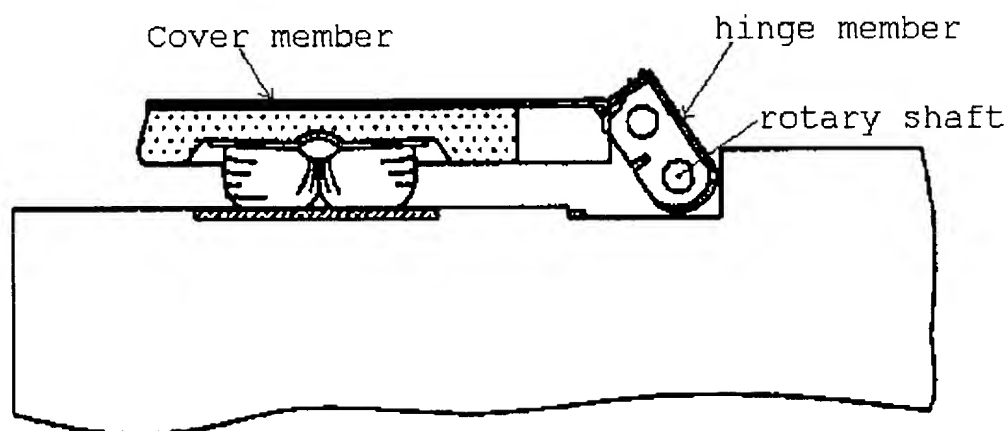
Art Unit: 2625

a direction in which said cover member is opened with respect to said hinge member and is further biased in a direction parallel to an axis of a rotary shaft of said hinge member by a spring." This is an important point since, in the examination of a patent, it is the precise wording of the claim limitations that are considered by Examiner. Furthermore, Applicant is respectfully reminded that, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Now, as clearly set forth on page 3 of the previous office action (mailed 04 August 2006), Lee teaches that "said cover member can be rotated in a direction in which said cover member is opened with respect to said hinge member (figure 9B and column 6, lines 17-26 of Lee), and can be further rotated in a direction parallel to the axis of a rotary shaft (figure 9B(98) of Lee) of said hinge member (figure 3; figure 9B; and column 5, lines 34-39 of Lee)." Applicant will note in figure 9B of Lee (shown with different details below) that the cover member has two articulations that allows said cover member to rotate (1) in the direction in which the cover member is opened with respect to the hinge member, and (2) in a direction parallel to the axis of a rotary shaft of said hinge member. The axis of rotation of the rotary shaft is a direction into or out of the page, depending on whether the hinge member is rotating upward or downward. The hinge member also has a second rotary shaft above the rotary shaft specifically noted in the drawing below. The cover member also turns upon this upper rotary shaft. Since the bottom rotary shaft and upper rotary shaft each have parallel axes of rotation (into or out of the page), and the cover member

Art Unit: 2625

also rotates via the rotation of the upper rotary shaft, then the rotation of the cover member is parallel to the axis of a rotary shaft (namely the bottom rotary shaft) of said hinge member. The axis of rotation of the cover member is into or out of the page, and the axis of rotation of the labelled rotary shaft is also into or out of the page, though displaced from the axis of rotation of the cover member.



taken from
Figure 9B

The only aspect of recited claim 1 that is absent in Lee is that said cover member is specifically biased by a *spring* in the directions in which said cover member can be rotated. In other words, Lee is deficient only in that it does not teach that a

Art Unit: 2625

spring performs the biasing. Fujitaka teaches "biasing a cover member with respect to a hinge member by a spring (column 10, lines 1-10 of Fujitaka)", which can clearly be applied to the teachings of Lee to produce an obvious variation, as set forth on pages 3-4 of said previous office action.

With respect to argument (4): Motivation to combine the references is also clearly set forth in said previous office action. Examiner stated in said previous office action that the motivation to combine the teaching of Fujitaka with respect to using a spring biasing with the system taught by Lee would have been "to compensate for the effects of the weight of large, thick media that is to be scanned (column 10, lines 1-4 of Fujitaka)". While it is permitted for Examiner to use what would have been readily apparent and known to those of one of ordinary skill in the art at the time of the invention when determining motivation, Applicant will note that the motivation to combine Fujitaka with Lee comes directly from the Fujitaka reference. Thus, motivation is clearly established and a proper *prima facie* case of obviousness has been presented by Examiner.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Thompson whose telephone number is 571-272-7441. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the

Art Unit: 2625

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



10 November 2006

James A. Thompson
Examiner
Technology Division 2625